THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL H. HAMISCH JR.,

Appeal No. 1996-3198
Application No. 08/371,642[1]

HEARD: November 15, 1999

Before PAK, WARREN, and KRATZ, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 2 and 5-12. Claims 13 and 4, which are all of the remaining claims pending in this application, have been

[1] Application for patent filed January 12, 1995.

indicated as allowable by the examiner (final rejection, page 2).

BACKGROUND

The appellant's invention relates to a hand-held labeler having an elastomeric member placed on the handle exterior and a method of making the labeler. According to appellant, the provision of elastomeric material for the handle helps to "...prevent slippage..." and "...absorb the impact..." when using the labeler (specification, pages 1 and 2, carryover paragraph). An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, which are reproduced below.

1. A hand-held labeler, comprising: a housing having a manually graspable handle which subjects the user to impact during use, means on the housing for mounting a label supply roll of a composite web having labels releasably adhered to a carrier web, a platen, a print head cooperable with the platen for printing on the labels, means for delaminating printed labels from the carrier web, means for applying printed labels, means for advancing the composite web to peel a printed label from the carrier web and advance the printed label into label applying relationship with label applying means and to advance another label into the printing position, wherein the advancing means includes an operating lever disposed at the handle and engageable by the user’s fingers, wherein the handle includes a substantially rigid handle member, a frictional elastomeric member on the exterior of the handle member, and the

elastomeric member being receivable against the palm of the user's hand for helping to absorb the impact on the user's palm resulting from use of the labeler.

11. Method of making a hand-held labeler, comprising the steps of: providing a housing having a manually graspable handle, the handle having a pair of handle sections, means on the housing for mounting a label supply roll of a composite web having labels releasably adhered to a carrier web, a platen, a print head cooperable with the platen for printing on the labels, means for delaminating printed labels from the carrier web, means for applying printed labels, means for advancing the composite web to peel a printed label from the carrier web and advance the printed label into label applying relationship with the label applying means and to advance another label into the printing position, wherein, the advancing means includes an operating lever disposed at the handle and engageable by the user's fingers, wherein the handle includes a substantially rigid handle member, and molding elastomeric material onto the handle.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bronson	1,934,256	Nov. 07, 1933
Hamisch, Jr. (Hamisch)	4,116,747	Sep. 26, 1978
Araujo et al. (Araujo)	5,403,430	Apr. 04, 1995

(Filed Jan. 14, 1994)

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo. Claims 5-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo and further in view of Bronson.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions and evidence furnished by the appellant and the examiner. This review leads us to conclude that the examiner's
§ 103 rejections of claims 1, 8, and 9 are sustainable. However, we will not affirm the examiner's § 103 rejections of claims 2,
5-7, and 10-12. Our reasons for these determinations follow.

Initially, we note that appellant states "[a]ll of the appealed claims are submitted to be patentable and each claim is argued separately." (Brief, page 4). Accordingly, we shall treat the claims separately to the extent appellants have argued the limitations of each claim separately consistent with 37 CFR
§ 1.192 (c)(7) and (8) (1995). See page 3 of the examiner's answer.

Appellant acknowledges that Hamisch discloses a hand-held labeler corresponding to the labeler called for in appealed

claim 1 (brief, page 7 and specification, page 4) except for the recited "frictional elastomeric member on the exterior of the handle member...." According to the examiner, Araujo discloses an elastomeric cover for a hand-held applicator as a grip (answer, page 4), and it would have been obvious to one of ordinary skill in the art to modify the hand-held labeler of Hamisch to include such a cover on the handle of the labeler for providing a better grip thereto. We note that appellant does not specifically dispute the examiner's holding (implicit in the stated rejection) that the claimed foam handle grip or sleeve of Araujo (column 4, lines 53 and 54 and column 5, lines 21-25) corresponds to the claimed frictional elastomeric member. On this record, it is our view that a skilled artisan would have been imbued with a reasonable expectation of success in improving the gripping surface of the handle of Hamisch's labeler by adding a foam sleeve cover thereto which corresponds to the claimed elastomeric cover as taught by Araujo. Moreover, on this record, we are of the opinion that it would have been obvious from the combined teachings of Hamisch and Araujo to select a foam sleeve cover material with a desired hardness value, such as that recited in claims 8 or 9, to

obtain the expected enhanced gripping surface for the handle of the labeler.[2] This is especially true where, as here, appellant has not established, either in the specification or through evidence in the record, that the particular hardness value of the handle cover material as claimed is critical. *See In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In light of the above, we agree with the examiner that the subject matter of claims 1, 8, and 9 would have been *prima facie* obvious from the combined references' teachings.

We do not share appellant's viewpoint that the evidence furnished by appellant (declaration of Borcher, filed October 10,

1995 and admitted prior art labelers in the amendment of October 10, 1995; pages 3 and 4), which allegedly demonstrates large sales and use of labelers without an elastomeric cover for the handle, supports appellant's contention that patentability lies in the discovery of the impact problem and

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[2]A discussion of Bronson is not necessary to our decision.

alleged solution thereof. Clearly, the discovery of any problem with impact on the hands of users of the prior art hand-held labelers would have been manifest to one of ordinary skill in the art upon such use. *See In re Ludwig*, 353 F.2d 241,243, 147 USPQ 420, 421 (CCPA 1965); *In re Goodman*, 339 F.2d 228, 232-33, 144 USPQ 30, 33-34 (CCPA 1964). Thus, one of ordinary skill in the art would have been led to use an elastomeric cover with a desired hardness on the prior art labelers with a reasonable expectation of reducing the impact. See also *In re Huang*, 100 F.3d 135, 40 USPQ2d 1685 (Fed. Cir. 1996). In any event, for the reasons expressed in the answer and above, a skilled artisan would have been motivated to modify the labeler of Hamisch to include a cover material as claimed to obtain a better grip thereon in light of the combined teachings of the references. The fact that the reason or motivation to modify Hamisch's labeler advanced by the examiner may be for providing a better grip rather than solving a problem with reducing impact on the hands of a user of the device does not detract from the combinableness of the references or suggest impermissible hindsight reasoning as

alleged by appellant. In this regard, it is not necessary that the prior art suggest the combination to achieve the same advantage or result allegedly discovered by applicant. *See In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1900 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) *and In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Under the circumstances recounted above, it is our determination that the evidence of record for and against a conclusion of obviousness of the subject matter of claims 1, 8 and 9 considered in light of the respective arguments advanced by the appellant and the examiner, on balance, weighs most heavily in favor of an obviousness conclusion with respect to the rejections under consideration.

Appellant simply has not shouldered the burden of presenting convincing countervailing evidence of nonobviousness by merely presenting the declaration of Borcher and other information. *Compare Huang*, 100 F.3d 135, 40 USPQ2d 1685. Accordingly, we will sustain the examiner's § 103 rejection of claim 1 as unpatentable over Hamisch in view of Araujo and separately stated § 103 rejection of claims 8 and 9 as

unpatentable over Hamisch in view of Araujo and further in view of Bronson.

However, we cannot sustain the examiner's § 103 rejection of claim 2 over Hamisch in view of Araujo and § 103 rejection of claims 5-7 and 10-12 over Hamisch in view of Araujo and Bronson. Regarding claim 2, we note that the labeler requires a pair of handle sections each having an elongate exterior recess for receiving elastomeric sections as argued. The examiner has not explained how the applied references reasonably teach or suggest such structure including a recess in each section. In this regard, we note that Araujo suggests a sleeve for the handle, not a recess mounted material.

Claim 11 requires a method including molding the elastomeric material to a labeler handle; claim 12 additionally requires keying of the elastomer to the handle as part of the method; and claim 5 requires a means for keying the elastomeric material to the handle of a labeler device. The examiner additionally cites the Bronson patent which is directed to a running board cover. However, like appellant, we do not envision how a skilled artisan would have been led to the claimed labeler with a molded and/or keyed elastomeric handle

from such disparate prior art selections as culled by the examiner, without the benefit of impermissible hindsight. With regard to claims 6 and 7, the thickness of the elastomer is required to be varied. Here, the examiner has not explained how the applied references would have suggested modifying the apparently uniformly thick sleeve of Araujo for application to a labeler as claimed. Accordingly, we cannot sustain the examiner's stated rejection(s) of claims 2, 5-7, and 10-12.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo and to reject claims 8 and 9 under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo and further in view of Bronson is affirmed. However, the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo and to reject claims 5-7 and 10-12 under 35 U.S.C. § 103 as being unpatentable over Hamisch in view of Araujo and further in view of Bronson is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

CHUNG K. PAK Administrative Patent Judge	)
CHARLES F. WARREN Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
PETER F. KRATZ Administrative Patent Judge	)

PFK/jlb

MONARCH MARKINGS SYSTEMS, INC.
P.O. BOX 608
DAYTON, OH 45401